REMARKS

Status of Claims

The Office Action mailed August 11, 2005 has been reviewed and the comments of the Patent and Trademark Office have been considered. Applicants appreciate the withdrawal of all of the earlier applied rejections.

Claims 1-22 were pending in the application. Claims 2, 21, and 22 have been amended and no claims have been canceled or newly added. Therefore, claims 1-22 are pending in the application and presented for reconsideration.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Prior Art Rejections

In the Office Action, claims 1, 2, 6, 7, and 11-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over XML and EDI – Peaceful Co-Existence article (hereafter "Ricker") and further in view of U.S. patent 5,572,670 to Puckett (hereafter "Puckett"). Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker and Puckett, and further in view of U.S. patent 6,708,166 to Dysart et al. (hereafter "Dysart"), and further in view of U.S. Patent 5,526,484 to Casper et al. (hereafter "Casper '484"). Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker, Puckett, Dysart, and Casper, and further in view of U.S. patent 6,157,988 to Dowling (hereafter "Dowling"). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker and Puckett, and further in view of Casper '484. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker and Puckett, and further in view of U.S. patent 4,945,479 to Rusterholz et al. (hereafter "Rusterholz"). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker and Puckett, and further in view of U.S. patent 5,406,563 to Loebig (hereafter "Loebig"). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker, Puckett, Loebig, and further in view of Casper. Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ricker and Puckett, and

further in view of U.S. patent 6,310,888 to Hamlin (hereafter "Hamlin"). Applicants respectfully traverse these rejections for at least the following reasons.

Each of the independent claims 1, 18, 19, and 20 recite a system, method or program product that, *inter alia*, tracks errors in inbound documents received from trading partners in a business-to-business electronic commerce system in which (1) a translator checks compliance of the document for translation from a source format to a desired target format, and (2) on attempting translation of the document, *error data detected in the translation* are captured to a tracking database. At least this recited feature is not disclosed or suggested by the applied prior art.

The Office Action acknowledges that this recited feature is not disclosed in Puckett. Instead the office action states that this Ricker discloses this features and cites to figure 9 and page 8 of Ricker. However, neither figure 9 or page 8 of Ricker (nor the rest of its disclosure) discloses or suggests (1) that the *translation* error (of an inbound document from a trading partner) is captured to a tracking database. Ricker merely discloses that "the translator uses the X12 data dictionary to transform an EDI message into an XML document...." However, nowhere does this disclosure teach or suggest that that the translation errors in the inbound document from a trading partner are captured to a tracking database. Furthermore, nowhere does Ricker disclose or suggest that (2) an internal document identifier is saved to the tracking database that servers as an index for the translation error data.

As had been noted previously, Puckett is not relevant to claimed invention since it relates to a translator that translates low level error data (for example, binary records) stored in an error database to a more intelligible form and correlates higher level queries to the lower level error data stored in the error *log* database 168.. The error data stored in the error log database is derived from system *log* files in a mass data storage system. See col. 2, lines 17-20 and col. 3, lines 4-12 of Puckett. Therefore, the error processing in Puckett has nothing to do with the (1) claimed capturing of *translator error data* in a tracking database that represents errors in inbound document which are detected in the translation process. Furthermore, since Puckett has nothing to do with an inbound trading partner document, it necessarily does not teach or suggest anything related to (2) an internal document identifier being saved to the tracking database that serves as an index for the translation error data.

Therefore, these recited features are <u>not</u> disclosed by either Ricker or Puckett and therefore also not disclosed by their reasonable combination. Since these deficiencies in Ricker and Puckett are not cured by any of the other applied references, the office action fails to make a *prima facie* case of obviousness as required by section 103.

In this context, it should be noted that Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is "obvious" (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO's review court has made it very clear that *silence* in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a <u>whole</u>.

In this context, it appears that the rejections in the office action of claims 11 and 12, for example, appear to be erroneous. The office action states with respect to the features of claim 11, that "these errors can be errors about the storage system or simply routine observations about the storage system." However, equating the errors related to the "storage system" to the claimed document information is incorrect since one skilled in art in either the computing systems or e-commerce system art would not equate a trading partner document to a storage system disclosed by Puckett. Likewise, the rejection of claim 12 does not indicate how translation errors in trading partner documents are correlated to variables and stored referenced to the internal document identifiers (which are not disclosed by any of the applied references).

Claims 21 and 22 recite that translation error data of an inbound document of a trading partner is used <u>to provide information *to* the trading partner</u> based on the identified translation error data. The office action relies on col. 3, lines 5-15, which merely discloses that if a source process (which the examiner presumably equates to the trading partner) does not receive an acknowledgement, the source process presumably generates the error

notification which is very different than the claimed feature that requires providing information to the trading partner based on the identified error data.

Therefore, these features recited in the dependent claims discussed above are also not disclosed or suggested by the applied prior art and they provide additional reasons for the patentability of these claims.

Conclusion

In view of the foregoing amendments and remarks, applicants believe that the application is now in condition for allowance. An indication of the same is respectfully requested. If there are any questions regarding the application, the examiner is invited to contact the undersigned attorney at the local telephone number below.

> **Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.**
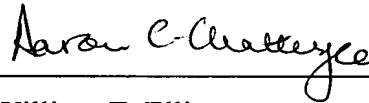
Respectfully submitted,

Date November 9, 2005   By _____

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